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dan@danpolley.com
betty@danpolley.com
beatrizbernal@bellsouth.net

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFERY N. WEISS

Appeal 2009-007501
Application 09/848,753
Technology Center 2600

Before KENNETH W. HAIRSTON, ELENI MANTIS MERCADER,
and CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.

HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1, 2, 4, 5, 8 to 23, and 25 to 29. Claims 3, 6, 7, and 24 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We will sustain the indefiniteness rejection of claim 25 under § 112, second paragraph, and reverse the indefiniteness rejection of claims 9, 10, and 12 under § 112, second paragraph. We will sustain the obviousness rejections of claims 1, 4, 8 to 11, and 13 to 23, and 25 to 29 under 35 U.S.C. § 103(a), and reverse the obviousness rejection of claims 2, 5, and 12 under 35 U.S.C. § 103(a).

Appellant's claimed invention is directed to an incoming telephone call blocking method and device that selectively blocks calls based on a user entering or not entering a code (Spec. 1:14-23). The calls are blocked during periods of time selected by a user. Appellant discloses and claims an incoming telephone call blocking device that allows call to come in during a selected time period when the caller enters the correct code (claim 1; Spec. 1:14-23; Abs.). Appellant also discloses and claims disconnecting a telephone by opening a series switch and closing two vertical switches during a blocking mode which occurs at certain selected times of day (Spec. 5:24-30; claims 2, 5, and 12).

Claims 1 and 2 are representative of the claims on appeal, and read as follows:

Claim 1. An incoming telephone call blocking device associated with a telephone line operatively associated with a user's telephone, said blocking device comprising:

means for setting an activation period for blocking of incoming telephone calls, said activation period including a user entered starting time for blocking of incoming telephone calls;

means for requesting a caller during the activation period to enter a code for passing the incoming telephone calls;

means for determining if a correct code has been entered by the caller;
and

means for allowing an incoming telephone call of the caller to pass through during the activation period where it is determined that the caller has entered a correct code.

Claim 2. The telephone call blocking device of claim 1 wherein when not in the activation period the user's telephone is connected with the telephone line through the closing of a series switch; wherein when blocking has been activated the user's telephone is disconnected from the telephone line by the opening of the series switch and closing of a first vertical switch and a second vertical switch.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Novak	US 4,266,098	May 5, 1981
Lee	US 5,604,791	Feb. 18, 1997
Horne	US 6,298,122 B1	Oct. 2, 2001
		(filed Dec. 7, 1998)

The Examiner rejected claims 9, 10, 12, and 25 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which is regarded as the invention.

The Examiner notes several lines of claims 9, 10, and 12 without explaining what those lines contain or if and how the wording found in those

lines causes indefiniteness (Ans. 3). The Examiner notes that claim 25 depends from canceled claim 24 (Ans. 3).

The Examiner rejected claims 1, 2, 4, 5, 8, 9, 13, 14, 17, 18, and 25 to 29 under 35 U.S.C. § 103(a) based upon the teachings of Novak and Horne.

The Examiner rejected claims 10 to 12, 15, 16, and 19 to 23 under 35 U.S.C. § 103(a) based upon the teachings of Novak and Horne, further in view of the teachings of Lee.

In both of the obviousness rejections, the Examiner determines (Ans. 4-5) that it would have been obvious to incorporate the activation period taught by elements 302 and 304 (Figure 3) of Horne in the incoming telephone call blocking method and device of Novak “as such would make the Novak device and method more convenient” (Ans. 4).

ISSUES

First Issue: § 112, Second Paragraph, Rejection

Appellant argues (Br. 4-5) that the wording of claims 9, 10, 12, and 25 does not rise to the level of a § 112, second paragraph, rejection. Appellant requests (Br. 4) that the Board consider claim 25 to be dependent upon claim 17 for purposes of this appeal.

Based on Appellant’s arguments, the first issue is: are claims 9, 10, 12, and 25 indefinite based on the Examiner having set forth a proper basis for finding these claims indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention?

Second Issue: Obviousness of Claims 1, 4, 8 to 11, 13 to 23, and 25 to 29

With regard to the obviousness rejection of claims 1, 2, 4, 5, 8, 9, 13, 14, 17, 18, and 25 to 29, Appellant argues (Br. 6-8) that Novak and Horne

fail to teach, suggest, or provide motivation for incorporating elements 302 and 304 (i.e., activation period setting means) into the telephone call blocking device of Novak. With regard to the obviousness rejection of claims 10 to 12, 15, 16, and 19 to 23, Appellant argues (Br. 8-9) that although Lee shows a speaker 223, Lee fails to cure the deficiencies of Novak and Horne.

Based on Appellant's arguments, the first second is: would it have been obvious to modify the telephone call blocking device of Novak with the elements 302 and 304 (i.e., activation period setting means) of Horne in order to make the device and method of Novak more convenient, as set forth in claims 1, 15, and 17 on appeal?

Third Issue: Obviousness of Claims 2, 5, and 12

With regard to claims 2, 5, and 12, Appellant argues (Br. 7) that Novak and Horne fail to teach or disclose the claimed switches.

Based on Appellant's arguments, the third issue: has the Examiner properly addressed the limitations of a series switch and vertical switches, and made a prima facie case of obviousness for claims 2, 5, and 12 on appeal?

FINDINGS OF FACT

1. Novak describes an incoming telephone call blocking method and device (Figs. 1 and 2) for preventing unwanted calls from disturbing a called party (Abs.). Novak sets conditions for accepting calls including having a caller input a predetermined code (col. 1, l. 47 to col. 2, l. 14), and using a clock 10 and processor 6 to program certain calls to be accepted at certain times while accepting other calls all the time (col. 2, ll. 21-22).

2. Horne describes a caller ID system and call screening method (Fig. 4) and system (Fig. 1) for blocking and screening incoming calls where an override code permits incoming calls to ring through (Abs.). Horne describes programmable system features for call screening such as TIME ON field 302, TIME OFF field 304, and other database fields like OVERRIDE code field 306 and allowable calling party entries 308 for activating and/or deactivating a period for call screening (Fig. 3; col. 7, l. 59 to col. 8, l. 27).

3. Lee describes a telephone answering system using a speaker 223 (Figure 13; col. 17, ll. 56-58) and a speaker 123 (Figures 5 and 12; col. 14, ll. 13-15) for emitting a ringing sound to alert a user of an incoming and/or desired call.

PRINCIPLES OF LAW

Indefiniteness

The test for definiteness under 35 U.S.C. § 112, second paragraph is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). Claims must “particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112, ¶ 2.

Obviousness

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). The

Examiner's articulated reasoning in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

ANALYSIS

First Issue: § 112, Second Paragraph, Rejection

The Examiner has not pointed out any specific limitations in claims 9, 10, and 12 that are indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. In the absence of any reasons for finding the claims indefinite, we hereby decline the Examiner's invitation (Ans. 3) to find indefiniteness as to claims 9, 10, and 12, and find that "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc.*, 806 F.2d at 1576. Accordingly, we will not sustain the Examiner's indefiniteness rejection of claims 9, 10, and 12 under § 112, second paragraph.

We also decline Appellant's invitation (Br. 4) to pretend for purposes of appeal (or for any other reason) that claim 25 depends from claim 17. The fact remains that claim 25 improperly depends from canceled claim 24, and thus does not particularly point out and distinctly claim the subject matter which the Appellant regards as the invention (*see* 35 U.S.C. § 112, ¶ 2) because those skilled in the art would not know what features are incorporated from the underlying claim from which claim 25 depends. *See Orthokinetics, Inc.*, 806 F.2d at 1576.

Accordingly, we will sustain the Examiner's rejection of claim 25 under § 112, second paragraph, as being indefinite.

Second Issue: Obviousness of Claims 1, 4, 8 to 11, 13 to 23, and 25 to 29

Turning now to the obviousness rejection of (i) claims 1, 4, 8, 9, 13, 14, 17, 18, and 25 to 29 over Novak and Horne, and (ii) claims 10, 11, 15, 16, and 19 to 23 over Novak, Horne, and Lee, we will sustain the Examiner's rejections of these claims for the reasons that follow.

We agree with the Examiner (Ans. 4-7) that the obviousness rejections of claims 1, 4, 8 to 11, 13 to 23, and 25 to 29 are proper because (i) Novak teaches the incoming telephone call blocking method and device as set forth in claims 1, 15, 17 except for the setting of an activation period, and (ii) Horne teaches setting an activation period. *See Fine*, 837 F.2d at 1073; *Kahn*, 441 F.3d at 988.

We agree with the Examiner (Ans. 3-7) that it would have been obvious to modify Novak's incoming telephone blocking system and method with Horne's activation period setting feature in order to make the device and method of Novak "more convenient" (Ans. 4). The Examiner has provided articulated reasoning with a rational underpinning to support the combination for the legal conclusion of obviousness (Ans. 3-8). *See Kahn*, 441 F.3d at 988. Appellant's contentions (App. Br. 5-8) that there is no motivation for making such a modification are unconvincing.

In view of the foregoing and Findings of Fact 1 and 2, Novak and Horne disclose or suggest all of the elements of claims 1, 4, 8, 9, 13, 14, 17, 18, and 25 to 29 of an incoming telephone call blocking method and device that allows calls through during an established activation period when the caller has entered the correct code. We will sustain the Examiner's rejection of claims 1, 4, 8, 9, 13, 14, 17, 18, and 25 to 29 as being obvious under § 103(a) over the combined teachings of Novak and Horne.

With regard to claims 10, 11, 15, 16, and 19 to 23, we note Appellant's admission (Br. 8) that Lee teaches a speaker. Although Appellant argues (Br. 8) that there is no teaching in Novak for redesigning circuitry and increasing the number of parts to include a separate speaker, we do not find this line of reasoning persuasive. We agree with the Examiner's reasoning that "[s]peakers are old in the art and it would have been obvious to one of ordinary skill to use a speaker wherever it was deemed necessary" (Ans. 5), and conclude that the ordinarily skilled artisan would not find it difficult to add a speaker or redesign a circuit to allow for user notifications of incoming calls and the like.

Novak, Horne, and Lee disclose or suggest all of the elements of claims 10, 11, 15, 16, and 19 to 23 of an incoming telephone call blocking device including a speaker that allows calls through during an established activation period when the caller has entered the correct code (*see* FF 1-3). Appellant has failed to persuade us that it would be improper to combine Lee's speaker with the method and device of Novak as modified by the activation period setting feature of Horne. In view of the foregoing, we will sustain the Examiner's rejection of claims 10, 11, 15, 16, and 19 to 23 as being obvious under § 103(a) over the combined teachings of Novak, Horne, and Lee.

Third Issue: Obviousness of Claims 2, 5, and 12

Turning now to the obviousness rejection of claims 2, 5, and 12 over the various teachings of Novak, Horne, and Lee, we agree with the Appellant's assertions (Br. 7) that Novak and Horne fail to teach or disclose the recited switches (e.g., series switch, answer switch, and first and second vertical switches), and their specifically claimed operations. We will not

sustain the Examiner's rejections of claims 2, 5, and 12 for at least the reason that no prima facie case of obviousness has been made.

The Examiner's inclusion of claims 2, 5, and 12 in the statement of the rejection of claim 1 from which these claims depend (Ans. 4-5) is insufficient as applied to claims 2, 5, and 12 because of the difference in claim scope. Specifically, the Examiner has not sufficiently addressed the limitations found in claims 2, 5, and 12 of (i) opening and/or closing a series switch and first and second vertical switches to connect a telephone line (claim 2), (ii) closing answer switch which also answers the incoming telephone call (claim 5), and (iii) detecting when a user's telephone is picked up to answer an incoming call during an activation period by closing a series switch and opening first and second vertical switches (claim 12). The Examiner fails to address these differing features of claim 2, 5, and 12, or Appellant's arguments with regard to these features, in the Response to Argument section of the Answer (*see* Ans. 5-7). Although the Examiner asserts (Ans. 3-4) that Appellant fails to provide any supporting description for the claimed series and vertical switches in the Specification, we note that the Specification describes vertical switches 14 and 16, and series switch 12, at page 5 therein. As a result, we find that the Examiner has neither provided (i) a factual basis to support the legal conclusion of obviousness (*see In re Fine*, 837 F.2d at 1073), nor (ii) articulated reasoning possessing a rational underpinning to support the legal conclusion of obviousness (*In re Kahn*, 441 F.3d at 988) as to claims 2, 5, and 12.

CONCLUSIONS OF LAW

For the foregoing reasons, we find that the Examiner erred in rejecting claims 9, 10, and 12 under § 112, second paragraph, as being indefinite, but not claim 25 which improperly depends from canceled claim 24. We also find that the Examiner erred in rejecting claims 2, 5 and 12 under § 103(a) as being obvious in view of the respective teachings of Novak, Horne, and Lee because the Examiner has failed to adequately address the various recited switches and the operation thereof in combination with the other limitations of the claims. Lastly, we find that the Examiner did not err in rejecting (i) claims 1, 4, 8, 9, 13, 14, 17, 18, and 25 to 29 under § 103(a) as being obvious in view of the teachings of Novak and Horne, and (ii) claims 10, 11, 15, 16, and 19 to 23 under § 103(a) as being obvious in view of the respective teachings of Novak, Horne, and Lee.

ORDER

We reverse the Examiner's rejections of claims 9, 10, and 12 under § 112, second paragraph, as being indefinite.

We affirm the Examiner's rejection of claim 25 under § 112, second paragraph, as being indefinite.

We affirm the Examiner's obviousness rejections of claims 1, 4, 8 to 11, 13 to 23, and 25 to 29 under § 103(a).

We reverse the Examiner's obviousness rejection of claims 2, 5, and 12 under § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED-IN-PART

KIS

DANIEL S. POLLEY, P.A.
1215 EAST BROWARD BOULEVARD
FORT LAUDERDALE, FL 33301